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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/997,706 12/23/97 EJIRI

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005514 LM31/0717
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NEW YORK NY 10112

EXAMINER

POKRZYWA, J

ART UNIT	PAPER NUMBER
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2722

DATE MAILED:

07/17/00

16

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/997,706

Applicant(s)

Ejiri, Seishi

Examiner
Joseph Pokrzywa

Group Art Unit
2722



☒ Responsive to communication(s) filed on May 9, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-23 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-23 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner:

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☒ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Continued Prosecution Application

1. The request filed on 5/9/00 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 08/997,706 is acceptable and a CPA has been established. An action on the CPA follows.

Response to Amendment

2. Applicant's amendment received on 4/13/00 has been entered and made of record. Also, applicant's preliminary amendments filed 5/9/00 and 6/2/00 have been entered and made of record. Currently, **claims 1 through 23** are pending.

Response to Arguments

3. Applicant's arguments with respect to independent **claims 1, 7, 13, and 17 through 23** have been considered but are moot in view of the new ground(s) of rejection.

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Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. **Claim 17** is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. **Claim 17** recites the limitation "said connection means" in lines 10 and 11. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. **Claims 1 through 4, 6, 7, 9 through 17, 21, and 22** are rejected under 35 U.S.C. 102(b) as being anticipated by Kikuchi *et al.* (U.S. Patent Number 5,552,901).

Regarding **claim 1**, Kikuchi discloses a data communication system (remote fax 9, see Fig. 4) which comprises a means (LAN control unit 21) for connecting a data processing terminal (fax server 1) to the data communication system (see Fig. 1, and column 5, lines 46 through 58), an operation means (operation control unit 22) for inputting a manual designation caused by an

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operator (column 8, line 55 through column 9, line 9, and column 11, line 61 through column 12, line 5), with the operation means being part of the data communication system (see Fig. 4, column 5, lines 59 through 62), a means (fax communication control unit 20) for transmitting data based on the designation input by the operation means (column 9, line 44 through column 10, column 10, line 56, and column 11, line 61 through column 12, line 28) through a line which is different from the connection means (public switched network 5, column 10, lines 57 through 67), and a means for notifying the data processing terminal (fax server 1) through the connection means (LAN control unit 21) of a transmission result information (column 17, lines 55 through 67) related to data transmission performed by the transmission means based on the designation input by the operation means in accordance with a change in state of the data communication system (column 18, lines 7 through 19).

Regarding *claim 2*, Kikuchi discloses the data communication system discussed in claim 1 above, and further teaches of the transmission means transmitting data on the basis of a second designation from the data processing terminal connected through the connection means (column 11, line 61 through column 12, line 28).

Regarding *claim 3*, Kikuchi discloses the data communication system discussed in claim 1 above, and further teaches of the transmission result information notified by the notification means includes a transmission destination (see Fig. 7, column 10, lines 10 through 25, and column 17, lines 55 through 67).

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Regarding *claim 4*, Kikuchi discloses the data communication system discussed in claim 1 above, and further teaches of the notification means performing notification in accordance with a change in information to be notified (column 17, line 55 through column 18, line 19).

Regarding *claim 6*, Kikuchi discloses the data communication system discussed in claim 1 above, and further teaches of the notification means notifying data transmitted by the transmission means (column 17, lines 55 through 67).

Regarding *claim 7*, Kikuchi discloses a data communication system (remote fax 9, see Fig. 4) which comprises a means (LAN control unit 21) for connecting a data processing terminal (fax server 1) to the data communication system (see Fig. 1, and column 5, lines 46 through 58), an operation means (operation control unit 22) for inputting a manual designation caused by an operator (column 8, line 55 through column 9, line 9, and column 11, line 61 through column 12, line 5), with the operation means being a part of the data communication system (see Fig. 4, column 5, lines 59 through 62), a means for designating an ID by an operation of the operation means (column 8, lines 58 through 64), a means for transmitting data based on the designation input by the operation means in accordance with the ID designation performed by the designation means (column 8, line 66 through column 9, line 9), a means for notifying the data processing terminal (fax server 1) through the connection means (LAN control unit 4) of information related to data transmission performed by the transmission means based on the designation input by the operation means in accordance with the ID designation performed by the designation means (column 8, line 58 through column 9, line 9, and column 17, line 55 through column 18, line 19),

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means for determining whether the ID is designated by the designation means or not (column 8, lines 37 through 54, and column 11, line 61 through column 12, line 18), and means for controlling the notification means in accordance with a determination result determined by the determination means (column 17, line 55 through column 18, line 19).

Regarding *claim 9*, Kikuchi discloses the data communication system discussed in claim 7 above, and further teaches of the ID designated by the designation means is information representing a user on a network (destination user identifiers, column 7, lines 10 through 16, and column 8, lines 58 through 67).

Regarding *claim 10*, Kikuchi discloses the data communication system discussed in claim 7 above, and further teaches of the transmission means transmitting data on the basis of a second designation from the data processing terminal connected through the connection means (column 11, line 61 through column 12, line 28).

Regarding *claim 11*, Kikuchi discloses the data communication system discussed in claim 7 above, and further teaches of the information notified by the notification means includes a transmission destination (see Fig. 7, column 10, lines 10 through 25, and column 17, lines 55 through 67).

Regarding *claim 12*, Kikuchi discloses the data communication system discussed in claim 7 above, and further teaches of the notification means notifying data transmitted by the transmission means (column 17, lines 55 through 67).

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Regarding *claim 13*, Kikuchi discloses a method of controlling a data processing terminal (fax server 1, see Figs. 1 and 3), connected to a data communication system (remote fax 9) for performing data communication with a destination (opposite fax 6). Kikuchi's method comprises a step of receiving a communication result information related to data communication performed by a manual operation performed by the data communication system (column 17, line 55 through column 18, line 19) via an operation unit which is part of the data communication system (operation control unit 22, see Fig. 4, column 5, lines 59 through 62), a step of instructing the data communication system to communicate with the destination (column 9, line 44 through column 10, line 67), and a step of independently storing the communication result information received in the reception step and communication result information related to data communication based on the instruction in the instruction step (see Fig. 7, column 6, line 64 through column 7, line 24).

Regarding *claim 14*, Kikuchi discloses the method discussed in claim 13 above, and further teaches of the information representing a user ID in the reception step (user identifier, column 8, lines 58 through 66), and the communication result information related to data communication are stored in an area corresponding to the user ID in the storage step (see Fig. 7, column 7, lines 10 through 25, and column 17, lines 55 through 67).

Regarding *claim 15*, Kikuchi discloses the method discussed in claim 13 above, and further teaches of the data received by the data communication system (remote fax 9) is received in the reception step (column 17, line 55 through column 18, line 19).

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Regarding *claim 16*, Kikuchi discloses the method discussed in claim 13 above, and further teaches of the communication result information received in the reception step includes a transmission destination (see Fig. 7, column 7, lines 10 through 25, and column 17, lines 55 through 67).

Regarding *claim 17*, Kikuchi discloses a method of controlling a system (see Figs. 1, 3, and 4) having a data communication system (remote fax 9) for performing data communication with a destination (opposite fax 6) and a data processing terminal (fax server 1) for controlling the data communication system. Kikuchi's method comprises the step of designating an ID on the basis of a manual operation (column 8, lines 58 through 64) by an operation unit (operation control unit 22) equipped with the data communication system (see Fig. 4, column 5, lines 59 through 62) and performing data communication (column 8, lines 58 through 66, and column 10, lines 57 through 67), and a step of notifying the data processing terminal (fax server 1) through a connection means (LAN control unit 21) of information related to the data communication to a data terminal (column 8, line 58 through column 9, line 9, and column 17, line 55 through column 18, line 19). Kikuchi's method further comprises the step of instructing the data communication system (remote fax 9) to communicate with the destination (opposite fax 6, column 9, line 44 through column 10, line 67), a step of receiving a communication result information notified by the data communication system (column 17, line 47 through column 18, line 19), and a step of independently storing the communication result information related to data communication based on the instruction in the instruction step and the communication result information received from

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the data communication system in the reception step (see Fig. 7, column 6, line 64 through column 7, line 24).

Regarding *claim 21*, Kikuchi discloses a data communication system (remote fax 9, see Fig. 4) which communicates with an external device (opposite fax 6) via a transmission path (public switched network 5), and which also communicates with a data processing terminal (fax server 1), comprising a signal path through which the data communication system (remote fax 9) communicates with the data processing terminal (LAN 4), an input section (operation control unit 22) through which an operator inputs a manual designation to the data communication system (column 8, line 55 through column 9, line 9, and column 11, line 61 through column 12, line 5), a transmitter (fax communication control unit 20) that, based upon the input manual designation, transmits data through the transmission path (public switched network 5) to the external device (column 10, lines 57 through 67, and column 12, lines 19 through 28), and a notifier (LAN control unit 21) which, because of a change in state of the data communication system (column 18, lines 7 through 19), notifies the data processing terminal (fax server 1) through the signal path (LAN 4) of a transmission result information corresponding to the data transmitted by the transmitter based upon the input manual designation (column 17, lines 55 through 67).

Regarding *claim 22*, Kikuchi discloses a method of controlling a data communication system (remote fax 9, see Fig. 4) which communicates with an external device (opposite fax 6) and a data processing terminal (fax server 1), comprising a step of inputting a manual designation to the data communication system (column 8, line 55 through column 9, line 9, and column 11,

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line 61 through column 12, line 5), a step of transmitting data to the external device (column 10, lines 57 through 67, and column 12, lines 19 through 28), via a transmission path (public switched network 5), based upon the input manual designation, with the transmitting step having a transmission result (column 7, lines 10 through 25), and a step of notifying, as a consequence of a change in a state of the data communication system (column 18, lines 7 through 19), and via a signal path (LAN 4) which is not the transmission path, the data processing terminal (fax server 1) of the transmission result (column 17, lines 55 through 67).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. **Claim 5** is rejected under 35 U.S.C. 103(a) as being unpatentable over Kikuchi *et al.* (U.S. Patent Number 5,552,901) in view of Otsuka (U.S. Patent Number 5,579,126).

Regarding *claim 5*, Kikuchi discloses the data communication system discussed in claim 1 above, and further teaches of the notification means notifying information related to the data transmission, but fails to specifically disclose of notifying information related to data transmission *upon completion* of the data transmission performed by the transmission means. Otsuka discloses

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a data communication system (facsimile apparatus 50) which comprises a means (concentrator 40) for connecting a data processing terminal (personal computer PC1, PC2, PCm) to the data communication system (see Fig. 1), an operation means (operation/display unit 10, see Fig. 2) for inputting a manual designation caused by an operator (column 4, lines 27 through 31), with the operation means being part of the data communication system (see Fig. 2), a means (NCU 19) for transmitting data through a line which is different from the connection means (telephone line, step 107 in Fig. 4, column 6, lines 54 through 60), and a means for notifying the data processing terminal (LAN interface 16) through the connection means (concentrator 40) of a transmission result information (transmission result record lists in Figs. 3C and 3D, column 5, line 44 through column 6, line 4) related to data transmission (step 203 in Fig. 5, column 7, lines 33 through 44). Further, Otsuka teaches of the notification means notifies information related to data transmission upon completion of the data transmission performed by the transmission means (step 110 in Fig. 4, and step 203 in Fig. 5, column 6, line 61 through column 7, line 44). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Otsuka's teachings in Kikuchi's system. Kikuchi's system would be easily modified with the inclusion of Otsuka's teachings, as the systems share cumulative features, being additive in nature.

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11. **Claims 8, 18 through 20, and 23** are rejected under 35 U.S.C. 103(a) as being unpatentable over Kikuchi *et al.* (U.S. Patent Number 5,552,901) in view of Hashimoto *et al.* (U.S. Patent Number 5,644,404, cited in the Office action dated 11/9/99).

Regarding **claim 8**, Kikuchi discloses the data communication system discussed in claim 7 above, but fails to specifically teach of the notification means not performing notification in an absence of an ID designated by the designation means. Hashimoto discloses the data communication system (facsimile server terminal 1, column 4, lines 52 through 58), and further teaches of a notification means not performing notification in an absence of an ID designated by the designation means (column 7, lines 46 through 67, and column 8, lines 15 through 32). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Hashimoto's teachings in Kikuchi's system. Kikuchi's system would be easily modified with the inclusion of Hashimoto's teachings, as the systems share cumulative features, being additive in nature.

Regarding **claim 18**, Kikuchi discloses a data communication system (remote fax 9, see Fig. 4) which comprises a connector (LAN control unit 21) for connecting a data processing terminal (fax server 1) to the data communication system (see Fig. 1, and column 5, lines 46 through 58), and operates with a method which includes a step of inputting a manual designation caused by an operator (column 8, line 55 through column 9, line 9, and column 11, line 61 through column 12, line 5) using an operation unit (operation control unit 22) which is part of the data communication system (see Fig. 4, column 5, lines 59 through 62), a step of transmitting data

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based on a designation input in the input step (column 9, line 44 through column 10, column 10, line 56, and column 11, line 61 through column 12, line 28) through a line which is different from the connector (public switched network 5, column 10, lines 57 through 67), and a step of notifying the data processing terminal (server 1) through the connector (LAN control unit 21) of a transmission result information (column 17, lines 55 through 67) related to data transmission performed in the transmission step based on the designation input in the input step in accordance with a change in state of the data communication system (column 18, lines 7 through 19).

However, Kikuchi fails to specifically teach of controlling the data communication system using a computer readable program being stored in a storage medium. Hashimoto discloses a computer readable program (column 5, lines 1 through 12) stored in a storage medium (HD 13) for controlling a data communication system (facsimile server terminal 1, column 4, lines 52 through 58) connected to a data processing terminal (terminal 3, column 4, lines 52 through 58) through a connector (LAN 4 connected to server terminal 1 in Fig. 2, and column 4, lines 48 through 56). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Hashimoto's teachings in Kikuchi's system, thereby controlling the data communication system using a computer readable program being stored in a storage medium. Kikuchi's system would conform with well known standards by incorporating a memory which includes control programs, as it is well known in the art to use programs stored in a memory for controlling facsimile machines, as recognized by Hashimoto.

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Regarding *claim 19*, Kikuchi discloses a data communication system (remote fax 9, see Fig. 4) which comprises a connection means (LAN control unit 21) for connecting a data processing terminal (fax server 1) to the data communication system (see Fig. 1, and column 5, lines 46 through 58), and operates with a method which includes a step of inputting a manual designation caused by an operator (column 8, line 55 through column 9, line 9, and column 11, line 61 through column 12, line 5) using an operation unit (operation control unit 22) which is part of the data communication system (see Fig. 4, column 5, lines 59 through 62), a step of designating an ID (column 8, lines 58 through 64), a step of transmitting data based on the designation input in the input step in accordance with the ID designation performed in the designation step (column 8, line 66 through column 9, line 9), a step of notifying the data processing terminal (fax server 1) through the connection means (LAN control unit 4) of information related to data transmission performed in the transmission step based on the designation input in the input step in accordance with the ID in the designation step (column 8, line 58 through column 9, line 9, and column 17, line 55 through column 18, line 19), a step of determining whether the ID is designated in the designation step (column 8, lines 37 through 54, and column 11, line 61 through column 12, line 18), and a step of controlling the notifying in accordance with a determination result determined in the determination step (column 17, line 55 through column 18, line 19).

However, Kikuchi fails to specifically teach of controlling the data communication system using a computer readable program being stored in a storage medium. Hashimoto discloses a

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computer readable program (column 5, lines 1 through 12) stored in a storage medium (HD 13) for controlling a data communication system (facsimile server terminal 1, column 4, lines 52 through 58) connected to a data processing terminal (terminal 3, column 4, lines 52 through 58) through a connector (LAN 4 connected to server terminal 1 in Fig. 2, and column 4, lines 48 through 56). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Hashimoto's teachings in Kikuchi's system, thereby controlling the data communication system using a computer readable program being stored in a storage medium. Kikuchi's system would conform with well known standards by incorporating a memory which includes control programs, as it is well known in the art to use programs stored in a memory for controlling facsimile machines, as recognized by Hashimoto.

Regarding *claim 20*, Kikuchi discloses a method of controlling a data processing terminal (fax server 1, see Figs. 1 and 3), connected to a data communication system (remote fax 9) for performing data communication with a destination (opposite fax 6). Kikuchi's method comprises a step of receiving a communication result information related to data communication performed by the data communication system (column 17, line 55 through column 18, line 19) using a manual operation unit which is part of the data communication system (operation control unit 22, see Fig. 4, column 5, lines 59 through 62), a step of instructing the data communication system to communicate with the destination (column 9, line 44 through column 10, line 67), and a step of independently storing the communication result information received in the reception step and

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communication result information related to data communication based on the instruction in the instruction step (see Fig. 7, column 6, line 64 through column 7, line 24).

However, Kikuchi fails to specifically teach of controlling the data communication system using a computer readable program being stored in a storage medium. Hashimoto discloses a computer readable program (column 5, lines 1 through 12) stored in a storage medium (HD 13) for controlling a data processing terminal (terminal 3, column 4, lines 52 through 58), connected to a data communication system (facsimile server terminal 1, column 4, lines 52 through 58) for performing data communication with a destination (fax 2, column 4, lines 4 through 52, 62 and 63). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Hashimoto's teachings in Kikuchi's system, thereby controlling the data communication system using a computer readable program being stored in a storage medium. Kikuchi's system would conform with well known standards by incorporating a memory which includes control programs, as it is well known in the art to use programs stored in a memory for controlling computers and facsimile machines, as recognized by Hashimoto.

Regarding *claim 23*, Kikuchi discloses a method of controlling a data communication system (remote fax 9, see Fig. 4) which communicates with an external device (opposite fax 6) and a data processing terminal (fax server 1), comprising a step of inputting a manual designation to the data communication system (column 8, line 55 through column 9, line 9, and column 11, line 61 through column 12, line 5), a step of transmitting data to the external device (column 10, lines 57 through 67, and column 12, lines 19 through 28), via a transmission path (public switched

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network 5), based upon the input manual designation, with the transmitting step having a transmission result (column 7, lines 10 through 25), and a step of notifying, as a consequence of a change in a state of the data communication system (column 18, lines 7 through 19), and via a signal path (LAN 4) which is not the transmission path, the data processing terminal (fax server 1) of the transmission result (column 17, lines 55 through 67).

However, Kikuchi fails to specifically teach of controlling the data communication system using a computer readable program being stored in a storage medium. Hashimoto discloses a computer readable program (column 5, lines 1 through 12) stored in a storage medium (HD 13) for controlling a data communication system (facsimile server terminal 1, column 4, lines 52 through 58) connected to a data processing terminal (terminal 3, column 4, lines 52 through 58) through a connector (LAN 4 connected to server terminal 1 in Fig. 2, and column 4, lines 48 through 56). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Hashimoto's teachings in Kikuchi's system, thereby controlling the data communication system using a computer readable program being stored in a storage medium. Kikuchi's system would conform with well known standards by incorporating a memory which includes control programs, as it is well known in the art to use programs stored in a memory for controlling computers and facsimile machines, as recognized by Hashimoto.

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Citation of Pertinent Prior Art

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Matsumoto (U.S. Patent Number 5,684,607) discloses a facsimile apparatus connected to a host computer.

Conclusion


13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joe Pokrzywa whose telephone number is (703) 305-0146. The examiner can normally be reached on Monday through Friday from 8:00 a.m. to 4:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles, can be reached on (703) 305-4712. The fax phone number for this Group is (703) 306-5406.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3800/4700.

Joseph R. Pokrzywa

July 13, 2000


EDWARD L. COLES
SUPERVISORY EXAMINER
GROUP